

algorithm.” Similarly, claim 19 of proposed Group II has elements directed both to “activat[ing]” a phone unit and a “billing algorithm” within that phone unit.

By dividing some of Applicants’ claim elements into one group and other of Applicants’ claim elements into a second group, the proposed restriction requirement may prevent Applicants from claiming their invention in a way which distinguishes the prior art. During the interview, Applicants’ attorney used the analogy of a chair composed of a seat, a seat back and four legs. With respect to at least some of Applicants’ claims, the present restriction requirement is analogous to putting the seat and seat back in one group and the four legs in a second group. In this analogy, such a restriction requirement would prevent the inventor from claiming the full chair.

Under MPEP Section 806.05(c)(II), this sort of subcombination restriction requirement is improper:

II. SUBCOMBINATION ESSENTIAL TO COMBINATION

If there is no evidence that combination AB_{sp} is patentable without the details of B_{sp} , restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B_{sp} constitutes the essential distinguishing feature of the combination AB_{sp} as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

In view of these problems, Applicants’ attorney and the Examiner discussed an alternative restriction requirement. More particularly, Applicants’ attorney and the Examiner agreed that Applicants’ method claims 1-10 and 32-44 could be classified in an alternative Group I and Applicants’ remaining system, software and apparatus claims 11-31 could be classified in an alternative Group II. Under this alternative grouping, Applicants’ would be willing to elect alternative Group II (i.e., claims 11-31).